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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,309	06/13/2001	Subbarao Surampudi	06816-005004 / CIT 2209-0	7023
20985	7590	11/14/2003	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			KALAFUT, STEPHEN J	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/881,309

Applicant(s)

SURAMPUDI ET AL.

Examiner

Stephen J. Kalafut

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/2/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-30, 33 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 27, 28 and 30 is/are allowed.
- 6) ☒ Claim(s) 8-26, 29 and 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 37-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend on canceled claim 7, and would therefore be incomplete.

Claims 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/881,222 in view of Fugita *et al.*, for reasons of record. See paper no. 7, pages 4 and 5. The Terminal Disclaimer of 9/2/03 does not mention the copending application, and thus does not remove this rejection.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term added to claim 18, "fluoropolymeric", used to describe the present binder, is broader than any term used in the original disclosure, and would thus constitute new matter. The original term "Teflon", not permitted in claim language because it is a trademark, would support

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the polymer polytetrafluoroethylene, but not any and all fluoropolymers. Likewise, the term "fluoropolymeric" in claim 29 would be broader than the perfluorosulfonic acids which are supported by the term "Nafion". This would likewise constitute new matter.

Claims 13, 14, 17, 19-21, 23, 25, 26, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawana *et al.* in view of Watanabe, for reasons of record.

Claims 15, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawana *et al.* in view of Watanabe as applied to claims 14 and 17 above, and further in view of Fujita *et al.*, for reasons of record.

Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawana *et al.* in view of Watanabe as applied to claim 21 above, and further in view of Sakairai *et al.*, for reasons of record.

Claims 1-3, 27, 28 and 30 are allowed. The Terminal Disclaimer of 9/2/03 has removed the double patenting rejection of claims 1-3, which was the only rejection applied thereto. Claims 27, 28 and 30 are now free of the informalities noted in the previous office action.

Applicant's arguments filed 9/2/03 have been fully considered but they are not persuasive.

Applicants argue that the Kawana *et al.* and Watanabe do not give sufficient guidance as to how to incorporate or retrofit electrodes laden with ion exchange resin into the specific structure of applicants' fuel cells. This appears to be a misunderstanding of what is required for a rejection under §103 to be valid. The rejection must show how to modify the disclosure of one reference (Kawana *et al.*) according to the teachings of another (Watanabe) to arrive at the presently claimed invention. Kawana *et al.*, in figure 1, shows a fuel cell with electrodes (1, 2) and an electrolyte (3) incorporated therein, and states that cells "of the construction shown in FIG. 1 were *assembled*" (emphasis added), thus implying that some type of construction took place. The details of how to assemble these parts into a complete cell appear to be so basic to the art that they are not particularly specified in this patent, and do not even need to be. As a general rule, patents are addressed to those who are skilled in the respective art, and thus to people who have some general knowledge of how to assemble their art's devices from the parts thereof. The main difference between Kawana *et al.* and the present invention is the composition of the electrodes, the present invention including an ionically conductive material or a wetting agent. The electrodes of Watanabe include Nafion, which is both ionically conductive and to some extent hydrophilic, and thus a wetting agent, due to its SO<sub>3</sub> groups. Nafion also falls within the present term "fluoropolymeric". Watanabe also teaches benefits which arise from using his electrodes (column 2, lines 24-26 and 34-36), thus giving motivation for their use over and above "obvious to try". In obviousness rejections, the question of "why" is at least as important as "how", and is thus satisfied by Watanabe. A collective reading of Watanabe and Kawana *et al.* would direct the artisan to use the electrodes of Watanabe in the fuel cell assembly process of Kawana *et al.* (column 2, lines 38-55), and thus use these electrodes in the resulting fuel cell.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 703-308-0433. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 703-308-2383. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

sjk



EXAMINER  
STEPHEN J. KALAFUT  
703-308-0433  
1700